

REMARKS

In the outstanding Office Action, claims 6 and 10-24 were rejected as being obvious over Jonsson United States patent number 5,746,120 in view of Mathey (US 2,232,956) or Nelson (US 2,711,026) or Peterson (US 3,318,005). Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness, the three basic criteria must be met. There must be some suggestion or motivation from the references themselves or the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be in the prior art, and not on the applicants' disclosure. MPEP Section 2142.

1a None of the cited references recognizes or addresses the problem of wire jamming in the feeding wheel of an apparatus for binding wire around an object and the solution of providing a measuring means separate from the feeding wheel. 1b Mathey teaches a measure meter, but it does not discuss a binding machine or method of binding an object and the problem addressed by the applicant's claims of separating the measure meter from the feed wheel in a binding machine. Nelson relates to an improved wire measuring device used in the manufacture of wire, and there is no disclosure relating to problems of the jamming of feed wheels generally, or jamming of feed wheels in wire binding machines. Likewise, Petersen relates to a strand measuring device, but like Mathey and Nelson, there is no disclosure the problem of wire jamming in the feed wheels of binding machines. Petersen relates to the manufacture of communication wires, not to binding machines. There is no discussion in Petersen of the problem of the wires jamming in a feed wheel.

2
As pointed out in MPEP Section 2143.01, the fact that references can be combined or modified is not sufficient to establish prima facie obviousness. Jonsson clearly indicates that the measurement means 33 is located at the in-feed wheel, and not separate from the feed wheel. The only teaching to provide measuring means separate from a feed wheel appears in applicant's specification. Applicant respectfully submits that the Examiner has used impermissible hindsight to reject the claims, and applicant respectfully traverses the Examiner's rejection of the claims.

In view of the foregoing remarks, the application is believed to be in condition for allowance, and early notice to this effect is earnestly solicited. If allowance of this application may be expedited by resolution of simple issues through a telephone conference, the Examiner is welcome to call the undersigned.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: February 9, 2004

Respectfully submitted,

By SS Servilla
Scott S. Servilla
Registration No.: 40,806
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant